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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,554	11/20/2001	David Carl Burdick	20257US1/110716	2152
7590	06/29/2004		EXAMINER	
BRYAN CAVE LLP 1290 AVENUE OF THE AMERICAS, 33RD FLOOR NEW YORK, NY 10104			QAZI, SABIHA NAIM	
		ART UNIT	PAPER NUMBER	
			1616	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/989,554	BURDICK ET AL.
Examiner	Art Unit	
Sabiha N. Qazi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 04 March 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 9-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 9-14 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

Claims 9-14 are pending. No claim is allowed. The arguments were fully considered and were found persuasive in part.

**RESPONSE TO REMARKS**

**Enablement Rejection**

The argument was found persuasive. Therefore, the rejection is withdrawn.

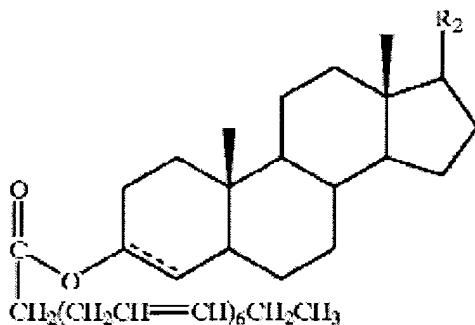
**Rejections under 103(a)**

The Examiner disagrees with the arguments because Higgins III US '068 does teach the presently claimed invention. It teaches the use of unsaturated fatty acid for the production of sterol ester. The unsaturated fatty acid includes linolenic acid and docosohexanoic acid, see US '068 in col. 2, lines 6 to 15.

See lines 16 to 26 in col. 2 of US '236 for the same disclosure. Therefore, the Examiner disagrees that CIP '236 does not teach the invention. Examiner agrees that examples and structures were not drawn in parent application however, the present invention was taught and considered obvious at the time of the invention.

1. Claim(s) 9-14 is rejected under 35 U.S.C. 103 as being unpatentable over Higgins, III (US Patent 5,892,068) and Higashidate et al. (J. of Chromatography, 515 (1990), 295-303). The references teach stero/stanol esters of poly unsaturated fatty acids and methyl esters of docosahexaenoic acid (DHA), which embrace instantly, claimed invention. See the entire documents especially lines 54-62 in col. 1; lines 6-15, col. 2 in US '068. See also claim 1 and

examples for the method of preparation of sterol esters. This compound is specifically taught by US '068 (lines 14 in col. 2).



$\beta$ -sitosterol docosahexaenoate; and  
 $\beta$ -sitostanol docosahexaenoate

See abstract and first Para on page 295, Table 1 and last two paragraphs on page 302 in Higashidate reference.

Instant claims differ from the reference in claiming nutritional supplement of specific sterol esters from C18 to C22 having at least three double bonds whereas prior art US '068 teaches sterol esters with unsaturated fatty acids, example given contains at least three double bonds (DHA) which is the same as one of the instantly claimed sterol ester i.e. sterol with DHA, sitosterol docosahexaenoate and sitostanol docosahexaenoate.

Higashidate teaches DHA and EPA from fish oils and prevent diseases such as arteriosclerosis and myocardial infarction by lowering the concentration of lipids and cholesterol in blood. It discloses that fish oil is a rich source of such fatty acids.

It would have obvious to one skill in the art to prepare additional beneficial nutritional supplement using sterols with a pendent ester functionality which when hydrolyzed provides another cholesterol-lowering agent. Since Higgins teaches such sterol esters and Higashidate

teaches that fish oil contains omega-3 fatty acids (a class of PUFA) which includes docosahexaenoic acid (DHA) and eicosahexaenoic acid (EPA), one would find ample motivation to prepare sterol esters with unsaturated fatty acids from active compounds present in fish oil (known to be used as nutritional supplement to lower the cholesterol and triglyceride levels) or using unsaturated fatty acids from any other source for use as nutritional supplement.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976)

A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982). Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In absence of any criticality and/or unexpected results, presently claimed invention is considered obvious over the cited prior art.

2. Claim(s) 9-14 are rejected under 35 U.S.C. 103 as being unpatentable over combined teachings of Mitchell (US 4,588,717) and Gregory J. Mishkel et al. (Bailliere's Clinical Haematology, Vol. 3, No. 3, July 1990, pp 625-649) and Kamarei et al. (US 4879,312). See the entire documents.

Mitchell (US Patent 4,588,717) teaches vitamin supplements containing phytosterol esters such as fatty acid esters of sterol, stigmasterol and taxasterol, in various combinations, a

composition of the phytosterols, such as sitosterol, stigmasterol, taraxasterol etc. reacted with polyunsaturated fatty acids such as linoleic acid, (18-carbons, two double bonds), linolenic acid (18-carbons, 3-double bonds), arachidonic acid (20-carbons, two double bonds). Fatty acid may have about 18-20 in addition to two carbon atoms of terminal carboxyl and methyl groups (lines 2-15, col. 6) and at least two double bonds such as arachidonic acid, linoleic acid and linolenic acids are used to make phytosterol esters, (see lines 21-58, col. 3; lines 43-65, col. 5; equation 1 and lines 1-11 in col. 8). Furthermore, it teaches that the reaction between any given phytosterol and any given fatty acid is essentially the same, and is characterized in equation 1 using sitosterol and linoleic acid as an exemplary fatty acid.

Mishkel et al. teaches that fish oil containing omega-3 fatty acids lower the serum and cholesterol levels, and their beneficial effect on preventing and treating cardiovascular disease. See 1<sup>st</sup> Para on page 626, third paragraph on page 629, second Para on page 628. See also last three paragraphs on page 632, Figure 3 on page 630. Specific use of DHA and EPA as dietary supplement are disclosed in section “Angina” on page 634.

Kamarei et al. teach that a diet rich in omega-3-fatty acids has beneficial effects in humans, including a reduction in plasma cholesterol and triglyceride levels, improved fat tolerance, prolonged bleeding time reduce platelet counts and decreased platelet adhesiveness. The omega-3-fatty acids are obtained mainly from dietary seafood. It teaches *n-3 Poly unsaturated fatty acids (PUFA) participation* and reasons why these materials may be involved in alleviating ischemic heart diseases. Furthermore, it also teaches that one of n-3 PUFA i.e. EPA and DHA reduces triglyceride and very low-density lipoprotein (VLDL) serum levels and reduces whole blood viscosity. (See lines 39-59, col. 2; lines 13-54, col. 3; Table 1 and 2 in col.

4). Instant claims differ from the reference in claiming nutritional supplement of phytosterol ester with specific fatty acids i.e. containing atleast 3 double bonds from *C18 to C22* such as docosahexaenoic acid, where US '717 teaches phytosterol ester with fatty acids especially containing poly unsaturated fatty acid approximately *2-22 carbon atoms*. See examples 51-75 in col. 6, equation 2 in cols 15, 16, 17 and 18. Mishkel et al. teaches that polyunsaturated fatty acids from fish oil is used to preventing and treating cardiovascular disease. Furthermore, it teaches two major biologically active fish oil compounds, EPA and DHA. Kamarie teaches n-3 PUFA i.e. eicosapentaenoic acid (EPA) and DHA reduces triglyceride and very low-density lipoprotein (VLDL) serum levels and reduces whole blood viscosity. (See lines 39-59, col. 2; lines 13-54, col. 3 and Table 1 and 2 in col. 4).

It would have been obvious to one skilled in the art to prepare additional beneficial nutritional supplement using sterols with a pendent ester functionality which when hydrolyzed provides another cholesterol-lowering agent. Since Mishkel teaches that fish oil contains omega-3 fatty acids (a class of PUFA) which includes docosahexaenoic acid (DHA) and eicosahexaenoic acid (EPA), see especially last para on page 625 of Mishkel reference). There has been ample motivation provided by the prior art to prepare the instant invention.

In absence of any criticality and/or unexpected results, presently claimed invention is considered obvious over the cited prior art.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Friday, June 25, 2004

SABIHA QAZI, PH.D  
PRIMARY EXAMINER